

REMARKS

In the Office Action, the specification was objected to under 35 U.S.C. §112, first paragraph, as failing to provide an adequate written description of the invention. Claims 8-14 were rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth in the objection to the specification. Claims 12-14 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 was rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process. Claims 8-11 were rejected under 35 U.S.C. §102(b) as being anticipated by Kinoshita et al. (U.S. Pat. Pub. No. 2001/0053816). Claim 15 was rejected under 35 U.S.C. §102(b) as being anticipated by Kunikane et al. (U.S. Pat. No. 6,308,961) or Toyosawa et al. (U.S. Pat. No. 6,399,696). Claims 12-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kinoshita as applied to claim 8 above, and further in view of Matsunaga et al. (U.S. Pat. Pub. No. 2005/0020740). Claims 8-13 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Pat. No. 7,050,263. Claims 8-13 were also

rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Pat. No. 7,099,111.

Two Terminal Disclaimers are attached to avoid the obviousness-type double patenting rejection. In addition, a Declaration of one of the inventors is attached evidencing the support in the specification of the ASTM and ISO equivalents for the cited Japanese standards.

Kinoshita et al. (U.S. Pat. Pub. No. 2001/0053816) teach a thermoplastic elastomer composition. However, Kinoshita et al. disclose that a styrene type elastomer (polystyrene resin) must be comprised in the composition as an essential element (claim 1 and Examples).

When a gasket is derived from a thermoplastic elastomer composition comprising a styrene type elastomer, a result from the compression set test performed using the gasket is a bad result (see Comparative Example 7 in Table 1 of the present specification).

Although Kinoshita et al. also disclose that an ethylene- α -olefin copolymer must be comprised in the composition, however, the molded product derived from the thermoplastic elastomer composition, which comprises an ethylene- α -olefin copolymer (Ethylene-octene-1 copolymer) and does not

comprise the polystyrene resin, has a low coatability (see Comparative Example 1 in Table 1 of the document).

Furthermore, Kinoshita et al. mentioned that ethylene- α -olefin copolymers containing no conjugated diene or non-conjugated diene are superior in weathering resistance and more preferred (paragraph [0026]). This is in contrast to the present invention.

In addition, the subject matter of the present invention is to provide a thermoplastic elastomer having an improved sealability under a high temperature (page 7, lines 17-20 of the present specification) but a coatability, when a gasket is derived from the thermoplastic polymer. This was validated by the compression set test. The gasket of the present invention satisfies a value of the compression set performed under 100 °C for 168 hours of less than 50% (page 22, lines 11 to 17 of the present specification).

On the other hand, Kinoshita et al. disclose that the compression test was performed under 70 °C for 22 hours (paragraph [0076]). Kinoshita et al. also disclose that the molded products having a value of compression set of even more than 80% were regarded as preferred Examples (for example, Examples 1, 5, 6 and 15). Meantime, a compression set test performed under 100 °C for 168 hours corresponds to that under 70 °C for 1000 or more hours.

Therefore, Kinoshita et al. fail to teach good performance at a high temperature.

Under the circumstances, claim 8 has been amended from the wording “A thermoplastic elastomer composition, comprising...” to “A thermoplastic elastomer composition, consisting of...” for clearly distinguishing the present invention from that of Kinoshita et al.

Kunikane et al. (U.S. Pat. No. 6,308,961) teach a gasket. However, Kunikane et al. intend to provide the gasket without using any adhesives (column 1, lines 60-64). The gasket is molded using a through-hole method.

To clearly distinguish the invention of current claim 15 from that of Kunikane et al., claim 15 has been amended to recite that an adhesive is used when a gasket is adhered to a surface of a first member. This amendment is supported by the description of page 20, line 6 of the present specification.

Toyosawa et al. (U.S. Pat. No. 6,399,696) teach a gasket. However, Toyosawa et al. fail to teach a specific cross-sectional shape of the gasket as recited in current claim 15. Thus, it is not possible to obtain a gasket having a similar cross-sectional shape based on the disclosure of Toyosawa et al.

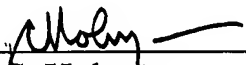
Matsunaga et al. (U.S. Pat. No. 6,399,696) fail to teach a specific composition as recited in current claim 8. Specifically, the composition disclosed by Matsunaga et al. does not contain a crystalline polyolefin resin.

Based on the foregoing amendments and remarks, it is respectfully submitted that the present application should now be in condition for allowance. A Notice of Allowance is in order, and such favorable action and reconsideration are respectfully requested.

However, if after reviewing the above amendments and remarks, the Examiner has any questions or comments, she is cordially invited to contact the undersigned attorneys.

Respectfully submitted,

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